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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,572	03/09/2004	Shinichi Yamada	HGM-133-A	2483

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EXAMINER

WILLIAMS, THOMAS J

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/796,572

Applicant(s)

YAMADA ET AL.

Examiner

Thomas J. Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-4, 6-11, 13, 14 and 16-18 is/are rejected.
7) ☒ Claim(s) 5, 12 and 15 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Acknowledgment is made in the receipt of the amendment filed March 11, 2005.

However, the examiner is unable to locate the translations of the priority documents filed March 11, 2005 as stated by the applicant.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 8-11 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2003/0047901 A1 to Hasegawa et al.

The applied reference has a common assignee and inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Re-claims 8 and 9, Hasegawa et al. discloses a motorcycle, comprising: a frame 3 having a head pipe 13 with an integral flange 3c extending rearwardly from a top portion, a steering column 14 is pivotally attached to the head pipe, the motorcycle comprises a rotary steering damper comprising: a damper housing 17 having a chamber 26 and a plurality of fluid flow

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connections (one on each side of the vane 30); a damper shaft 23; a vane 30 is disposed in the housing and is attached to the shaft 23; a hydraulic pressure control valve 31 for varying an attenuating force of the steering damper; wherein, upon pivotal motion of the vane in the housing, working fluid flows between a left and right chamber in the housing; the housing is attached to a vehicle body frame, the shaft 23 is attached to a steering system side, the housing 17 is disposed above a top bridge 11; the damper housing comprises a housing extension (see figure 3) that extends rearwardly behind the top bridge, an actuator 31/32 is connected to the control valve and is disposed below the housing extension. A topmost portion of the extension (as seen in figure 5) is located above the actuator.

Re-claim 10, the actuator comprises an electric solenoid, see paragraph 45.

Re-claim 11, the housing comprises a base 17 and a lid 18.

Re-claim 13, the apparatus is provided with brackets.

4. Claims 6, 7 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,824,153 to Hanawa et al.

Re-claim 6, Hanawa et al. discloses in figure 7 a steering damper for a vehicle wherein a pressure control valve 20 is interposed in an oil path formed in a damper housing provided between a vehicle body frame and a steering system, the pressure control valve is controlled to vary the attenuating force upon operation of the steering system, the pressure control valve comprises: an electric pressure control valve 20 in a connecting oil path 15 for communicating an exit side oil path L1 into which working fluid is discharged from an oil chamber R1/R2 of the damper housing and an entrance side oil path along which the working fluid returns to the oil chamber R1/R2 and is operable to change the attenuating force upon operation of the steering

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system in accordance with an electric signal (to solenoid 21); a mechanical pressure control device 30 is provided in a bypass oil path parallel to the electric pressure control device, the mechanical valve opens when the pressure in the bypass oil path becomes equal to a predetermined value.

Re-claims 7 and 18, the opening pressure of the mechanical valve 30 is lower than the opening pressure of the electric valve 20.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-4, 8-11, 13, 14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanawa et al.

Re-claims 1-4, 8-11, 13, 14, 16 and 17, (see above rejection of claim 6 further elaboration) Hanawa et al. teach the damper housing having an oil chamber (defined the

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combination of chambers R1 and R2, see column 3 lines 26-28) and a plurality of flow channels L1 and L2; a damper shaft; a vane; the pressure control valve varies an attenuating force; the housing is attached to the vehicle and the shaft is attached to the steering system; an actuator is associated with the pressure control valve; the apparatus is provided with brackets.

However, Hanawa et al. fail to teach the damper housing disposed above a top bridge or the actuator disposed below the housing. It would have been obvious to one of ordinary skill in the art to have as a matter of design choice to have simply disposed the housing above the top bridge of the vehicle and to have disposed the actuator below the housing in the apparatus of Hanawa et al., thus allowing for use on various vehicles and making the apparatus more compact, also shifting the placement of the recited elements does not effect their operation and the parts as rearranged in Hanawa et al. would have functioned equally well when having been repositioned. Furthermore, the simple rearrangement of parts has been held to be unpatentable, see *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

8. Claims 1-4, 6-11, 13-14 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2,814,362 to Sweeney, Jr.

Re-claims 1-4, 6, 8-11, 14, 16 and 17 Sweeney, Jr. teaches a steering damper (or rotary damper) for a vehicle having a pressure control valve 57 interposed in an oil path formed in a damper housing, the valve is controlled to vary an attenuating force upon operation of the damper, the apparatus comprising: a damper housing having an oil chamber I with a plurality of flow channels; a damper shaft; a vane; a hydraulic pressure control valve 57; a mechanical pressure control valve 58/59 is provided in a bypass oil path provided in parallel to the pressure control valve 57; the housing and shaft is capable of being adapted for connection to a vehicle

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body and steering system, with the housing capable of being adapted for connection above a top bridge as necessary. However, Sweeney, Jr. fails to teach the pressure control valve 57 being an electric solenoid as well as disposed in its entirety below the housing extension. It has been ruled by the courts that automating a manual activity that accomplishes the same result is not sufficient to distinguish over the prior art, see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). Furthermore, the simple rearrangement of parts has been held to be unpatentable, see *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). It would have been obvious to one of ordinary skill in the art to have simply replaced the manual valve 57 of Sweeney, Jr. with an automatic or electrically controlled valve, thus allowing for automatic or remote control of the valve and to have disposed the solenoid valve actuator in its entirety below the housing of Sweeney, Jr., thus making the apparatus more compact.

Re-claims 7 and 18, Sweeney, Jr. teaches that the mechanical pressure control valves open at a pressure higher than the pressure control valve 57.

Re-claim 13, the apparatus of Sweeney, Jr. is provided with brackets for connection to another structure.

Allowable Subject Matter

9. Claims 5, 12 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments filed March 11, 2005 have been fully considered but they are not persuasive. Regarding Hasegawa, it is the opinion of the examiner that chamber 26 is provided

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with a plurality of fluid flow channels connected thereto, see figure 4, each sub-chamber 27 and 28 is served by a fluid flow channel.

Conclusion

11. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Thomas Williams whose telephone number is 571-272-7128. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Bucci, can be reached at 571-272-7099. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-6584.

TJW

April 26, 2005

THOMAS WILLIAMS
PATENT EXAMINER

Thomas Williams

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4-27-05